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10/694,311	10/27/2003	Tommy L. Davis JR.	100038-0001 - B78494	3566
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AKIN GUMP STRAUSS HAUER & FELD, LLP			EXAMINER	
P O BOX 688			IWARERE, OLUSEYE	
DALLAS, TX 75313-0688			ART UNIT	PAPER NUMBER
			4127	
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			10/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/694,311 Examiner Oluseye Iwarere	DAVIS, TOMMY L. Art Unit 4127	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 10/27/2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-22 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 27 October 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>03/01/2004</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____ .

## DETAILED ACTION

1. This communication is a first Office Action Non-Final rejection on the merits.

Claims 1 – 22, as originally filed, are currently pending and have been considered below.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1 and 4 – 20 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Bowers et al. (5,963,134).**

**As per claim 1,** Bowers discloses, a system for tracking an authenticated item comprising:

an authentication device affixed to the item ([abstract]; uses RFID tags attached to each article);

an item registration system receiving authentication device data from the authentication device and associated item data and storing the authentication device data and the associated item data (col. 2, lines 16 – 19; via the identification information stored in the integrated circuit of an interrogated tag; and a database for receiving the interrogator output signals); and

an owner registration system receiving owner registration data after a buyer has acquired the item (col. 3, lines 30 – 34; via the database receives the patron identification information and the article identification information for each of the articles to be borrowed. The patron is construed as the buyer); and

a buyer verification system receiving the authentication device data, the associated item data and the owner registration data and storing buyer verified data if the associated item data correlates to the owner registration data (col. 11, lines 17 – 22; the patron may directly identify himself or herself to the system 50 by entering an ID and/or password into the computer terminal 52. The patron ID data is received by the computer terminal 52, which communicates with a database of patrons stored in the computer 48 to verify that the patron is authorized to check out articles 22).

**As per claim 4,** Bowers discloses, wherein the item registration system further comprises:

an item check-out system receiving item check-out data for the item when it is removed from inventory for use (col. 2, lines 18 – 21; via the database including inventory data for articles monitored by the system including checkout status data);

an item check-in system receiving item check-in data for the item when it is returned to inventory from use (col. 4, lines 27 – 29; via the inventory database receives the interrogator output signals and updates the checkout status data of the article being returned therewith); and

an event verification system providing event verification data associated with the item while it was in use (col. 20, lines 58 – 62; via the first interrogator receiving a response signal containing the stored article identification information for the article to be removed; a processor in communication with the first interrogator and the database).

**As per claim 5,** Bowers discloses, wherein the purchaser verification system further comprises a chain of custody system receiving purchase location data and determining whether chain of custody data exists for the item that ends at the purchase location (col. 1, lines 30 – 32; The database receives the patron identification information and the article identification information for each of the articles to be borrowed) (col. 4, lines 11 – 15; and updating the inventory database with the circulation status of the article to be removed) (FIG. 8 is a sample historical usage report 136).

**As per claim 6,** Bowers discloses, further comprising an alert system generating an alert to an operator if the associated item data does not correlate to the owner registration data (col. 5, lines 43 – 45; wherein the zone interrogator activates an alarm in response to the detection of the removal of an article from the predefined area).

**As per claim 7,** Bowers discloses, further comprising an item transfer system receiving purchaser data from an owner and requesting confirmation from a purchaser based on the purchaser data (col. 4, lines 52 - 57; via a processor in communication with the first interrogator and the database, the processor receiving the patron

identification information and the article identification information for the article to be removed from the first interrogator, and updating the inventory database with the circulation status of the article to be removed).

**As per claim 8,** Bowers discloses, further comprising a personage verification system receiving personage data and providing item data that corresponds to the personage data (col. 4, lines 43 – 44; a patron identification device for identifying a patron to the system).

**As per claim 9,** Bowers discloses, a method for tracking an authenticated item comprising:

affixing an authentication device to the item (col. 2, lines 1 – 2; Each of the articles has an RFID tag attached thereto);

storing authentication device data and item description data (col. 2, lines 4 – 5; the tag also includes an integrated circuit connected to the antenna for storing article identification information);

receiving owner registration data (col. 3, lines 24 – 26; the interrogator receives a response signal containing the stored article identification information for each of the articles to be borrowed and patron identification information from the ID card); and

generating confirmation data if the owner registration data and the item description data are correlated to the authentication device data (col. 17, lines 31 – 34; if the patron borrows an item from a multi-media lab, the patron's RFID card and the

article's jacket or holder (which is tagged) would be read and associated with each other).

**As per claim 10,** Bowers discloses, further comprising generating alert data if the owner registration data and the item description data are not correlated to the authentication device data (col. 12, lines 10 – 12; If an article 22 is not properly checked out, a visible and/or audio alarm is triggered to alert the patron and library employees to the problem).

**As per claim 11,** Bowers discloses, wherein affixing the authentication device to the item comprises affixing a radio frequency identification tag to the item (col. 2, lines 1 – 2; Each of the articles has an RFID tag attached thereto).

**As per claim 12,** Bowers discloses, wherein generating confirmation data if the owner registration data and the item description data are correlated to the authentication device data comprises determining whether item description data provided with the owner registration data matches item description data associated with the authentication device data (col. 20, lines 38 – 40; the processor receiving an output signal from the exit interrogator including the identification information of the response signal, wherein the processor compares the received identification information with the information stored in the database to determine whether the article is recorded therein as checked out).

**As per claim 13, Bowers discloses, further comprising:**

receiving personage data associated with the item (col. 4, lines 43 – 44; a patron identification device for identifying a patron to the system); and generating a report that includes the item data based on the personage data. (col. 4, lines 10 – 15; the processor receiving the patron identification information and the article identification information for the article to be removed from the first interrogator, and updating the inventory database with the circulation status of the article to be removed).

**As per claim 14, Bowers discloses, further comprising:**

receiving item transfer data from a current owner (col. 11, lines 28 – 32; via he patron manipulates either the article 22 to be checked out and/or the fixed interrogator 43 or scanner 42 so as to interrogate the tag 54 associated with the article 22 and read the data returned by the tag 54);

receiving transfer confirmation data from a prospective owner (col. 1, lines 36 – 39; via the tag serial number is sent directly, or through the computer terminal 52, to the computer 48 which locates the appropriate record for the article 22 in its database 66) (col. 12, lines 3 – 6; via to ensure that only articles 22 which were properly checked out are removed from the library 10, the pair of smart pedestals 36 (which incorporates the elements of the interrogator 100 of FIG. 3 therein) interrogates the articles 22 as they

pass through a zone in which a patron or employee must pass through to exit the library 10.); and

storing the prospective owner data as the owner registration data after receiving the transfer confirmation data. (col. 11, lines 40 – 42; via the database 66 is then updated to show that the article 22 has been checked out to the patron currently using the station 50).

**As per claim 15,** Bowers discloses, a system for authenticating an item comprising:

an owner registration system receiving owner registration data and item data (col. 11, lines 7 – 12; via when a patron wishes to check out an article 22 from the library collection, the patron identifies himself or herself to the system through a patron identification (ID) device 68. The patron ID device 68 may be a card reader, such as a bar code reader or magnetic stripe reader for reading data from a patron's library card. The patron ID device 68 may also be the same fixed interrogator 43 or RFID scanner 42 used for interrogating articles 22.);

an item registration system determining whether the item data matches stored item data (col. 2, lines 16 – 19; via the identification information stored in the integrated circuit of an interrogated tag; and a database for receiving the interrogator output signals);

an event verification system determining whether the item data matches stored event data (col. 11, lines 40 – 42; via the database 66 is then updated to show that the article 22 has been checked out to the patron currently using the station 50); and

wherein the owner registration data is stored as authenticated owner registration data if the item data matches the stored item data and the stored event registration data (col. 11, 19 – 27; via the patron ID data is received by the computer terminal 52 which communicates with a database of patrons stored in the computer 48 to verify that the patron is authorized to check out articles 22. If the patron is not in the patron database or if the patron is delinquent, the checkout procedure may be either terminated or the computer terminal may enter a patron registration routine. After the patron is identified and determined to be an authorized user, the checkout process may begin by performing the following steps).

**As per claim 16,** Bowers discloses, wherein the item registration system further comprises an item identification system receiving authentication device data from an authentication device attached to the item and storing the authentication device data as the item data (col. 2, lines 2 – 8; via each of the articles has an RFID tag attached thereto. Each tag includes an antenna for use in detecting the presence of the article by receiving an interrogation signal and returning a response signal. The tag also includes an integrated circuit connected to the antenna for storing article identification information and for outputting the article identification information with the response signal upon interrogation of the tag).

**As per claim 17,** Bowers discloses, further comprising an authentication device attached to the item in a manner that allows the authentication device to be read by an authentication device reader and that generates an indication if the authentication device is removed from the item (col. 21, lines 62 – 63; via the system according to claim 13 wherein the tag is a physically non-deactivatable tag).

**As per claim 18,** Bowers discloses, further comprising an owner flagging system receiving flag data for the item and generating item transfer data (col. 10, lines 35 – 38; via item identification information may also include any part of the bibliographic data, such as title, author, publisher and the like. optionally, the database record may include additional information, such as a predetermined location of a large library system where the article 22 is stored, which is understood as intended to facilitate the borrowing of the articles.)

**As per claim 19,** Bowers discloses, further comprising a buyer identification system receiving buyer identification data and generating buyer transfer query data (col. 3, lines 30 – 34; via the database receives the patron identification information and the article identification information for each of the articles to be borrowed).

**As per claim 20,** Bowers discloses, further comprising a buyer verification system receiving buyer transfer confirmation data and changing the owner registration

data to the buyer identification data (col. 11, lines 40 – 42; The database 66 is then updated to show that the article 22 has been checked out to the patron currently using the station 50).

**As per claim 22,** Bowers discloses, further comprising a tracking personalization system receiving item data and associating the item data with a personalization database ([abstract]; via an inventory database tracks all of the tagged articles and maintains circulation status information for each article).

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. **Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowers et. al. (5,963,134) in view of Molee et al. (5,380,047).**

As per claim 2, Bowers discloses, wherein the authentication device comprises:  
a radio frequency identification tag having a unique identifier ([abstract]; via using  
RFID tags attached to each article. Each tag has a unique identification or serial number  
for identifying the individual article).

However, Bowers fails to disclose a metallic tag having a hologram etched upon  
a surface and a peel-away adhesive layer affixed to the radio frequency identification  
tag and the metallic tag, wherein a portion of the peel-away adhesive layer remains  
affixed to the item if the authentication device is removed from the item.

Molee teaches a metallic tag having a hologram etched upon a surface (col. 2,  
lines 17 – 20; Through the use of a tamper proof hologram, the hologram 14 cannot be  
removed or copied without at least partially destroying the hologram);

and a peel-away adhesive layer affixed to the radio frequency identification tag  
and the metallic tag, wherein a portion of the peel-away adhesive layer remains affixed  
to the item if the authentication device is removed from the item (col. 2, lines 19 – 22;  
These tamper proof holograms are well known and comprise a hologram on a substrate  
with an overlying clear film).

From this teaching of Molee, it would have been obvious to one of ordinary skill  
in the art at the time the invention was made to modify the authentication device of

Bowers to include the hologram and peel-away adhesive layer taught by Molee in order to ensure an article is genuine and prevent the device from being tampered with.

**As per claim 3,** Bowers teaches, wherein the radio frequency identification tag, such that the radio frequency identification tag remains affixed to the item if the authentication device is removed from the item ([abstract]; via using RFID tags attached to each article. Each tag has a unique identification or serial number for identifying the individual article).

However, Bowers fails to explicitly disclose being affixed to the peel-away adhesive layer and is separate from the metallic tag.

Molee teaches affixed to the peel-away adhesive layer and is separate from the metallic tag (col. 2, lines 19 – 22; These tamper proof holograms are well known and comprise a hologram on a substrate with an overlying clear film).

From this teaching of Molee, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the authentication device of Bowers to include the peel-away adhesive layer, separate from the metallic tag, in order to facilitate check-in/checkout, inventorying, and theft control of articles.

**7. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bowers et. al. (5,963,134) in view of Conway (5,732,401).**

**As per claim 21,** Bowers discloses all the elements of the claimed invention, but fails to explicitly disclose, further comprising an item appraisal system receiving item appraisal data and associating the item appraisal data with item data.

Conway teaches, further comprising an item appraisal system receiving item appraisal data and associating the item appraisal data with item data (col. 2, lines 57 – 59; via costs may be tracked on a per-use or per-activity basis, or on a time basis, or both, whichever is the most accurate measure of the costs of personnel and/or equipment).

From this teaching of Conway, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system for tracking authenticated items of Bowers to include the appraisal system of Conway in order to establish profitable pricing.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mabry et al (6,330, 971) which discloses, radio frequency identification system and method for tracking silicon wafers, Kaufman et al. (6,774,811), which discloses designation and opportunistic tracking of valuables, Young (6,591,252) which discloses a method and apparatus for authenticating unique items, Scribner et al. (4,688,026), which discloses, a method of collecting and using data associated with tagged objects and Patel et al. (5,288,980), which discloses a library check out/check in system.

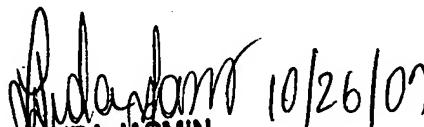
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Oluseye Iwarere whose telephone number is (571) 270-5112. The examiner can normally be reached on Monday to Thursday 7:30am to 5 (EDT).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynda Jasmin can be reached on (571) 272-3033. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OI



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SUPERVISORY PATENT EXAMINER